

REMARKS/ARGUMENTS

In the Office Action of March 21, 2005, Claims 66-81 are objected to as being misnumbered; Claims 1-7, 9-34, 36-39, 41-54, 56-80 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,571,220 B1 ("Ogino et al."); and Claims 8, 35, 40 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino et al. in view of NPL to Stallings ("Stallings").

1. Objection to the numbering of Claims 66-81.

Claims 66-81 have been amended so as to be properly numbered as Claims 65-80.

2. Rejection of Claims 1-7, 9-34, 36-39, 41-54, 56-80 under 35 U.S.C. 102(e).

Claim 1 has been amended to incorporate the claim limitations of Claim 3 and accordingly, Claim 3 has been cancelled.

As amended, the preprocessing unit remarks the material with a copy-no-more indication before providing the material on the preprocessing unit output if the copy-once indication is found and the copy-no-more indication is not found, and Ogino et al. fails to teach or suggest such a preprocessing unit.

Ogino et al. discloses two embodiments for a compliant recording apparatus (i.e., first embodiment compliant recording apparatus 200 as detailed in FIG. 6 and second

embodiment compliant recording apparatus 400 as detailed in FIG. 17). The material to be recorded by the compliant recording apparatus 200 or 400 may be provided by either a set top box 1 (as indicated in FIGS. 21 and 16) or a compliant reproducing apparatus 100 (as indicated in FIGS. 1 and 16). Block diagrams for the set top box 1 and the compliant reproducing apparatus 100 are respectively illustrated in FIGS. 2 and 10.

Functionally, the compliant recording apparatuses 200 and 400 of Ogina et al. are analogous to applicants' recording unit of Claim 1 since they perform the actual recording or copying of the material. See, e.g., 211 of FIG. 6 as described in Col. 10, lines 56-60 and S107 of FIG. 9 as described in Col. 11, line 62 to Col. 12, line 37 for the compliant recording apparatus 200. Also, see, e.g., 211 of FIG. 17 and S407 of FIG. 19 as described in Col. 18, line 65 to Col. 19, line 7 for the compliant recording apparatus 400.

Likewise, the set top box 1 and compliant reproducing apparatus 100 of Ogina et al. are analogous to applicants' preprocessing unit of Claim 1 since they check copy control information in watermarks in the material and only allow sending of the material to the compliant recording apparatus 200 or 400 if the watermarks do not indicate that the material is never to be copied (i.e., "Never Copy") or that no more copies are to be paid (i.e., "No More Copy"). See, e.g., FIG. 2 as described in Col. 10, lines 1-6 for the set top box 1, and FIG. 10 as described in Col. 13, lines 11-34 for the compliant reproducing apparatus 100.

As is evident from inspection of FIG. 2, the set top box 1, however, does not include a component for “remarking said material with said copy-no-more indication before providing said material on said preprocessing unit output if said copy-once indication is found and said copy-no-more indication is not found” as claimed in Claim 1. Therefore, the set top box 1 cannot anticipate the preprocessing unit of Claim 1.

Although the compliant reproducing apparatus 100 of FIG. 10 does include a WM adder 109, it does not add a copy-no-more indication (i.e., “No More Copy” by the notation used in Ogina et al.). Instead, it adds the electronic watermark information representing the “Never Copy”. See, Col. 13, lines 35-44. Therefore, the compliant reproducing apparatus 100 also cannot anticipate the preprocessing unit of Claim 1.

It is further to be noted that the first embodiment of the compliant recording apparatus 200 as shown in FIG. 2 includes a WM rewriting unit 207 that superimposes the electronic watermark information WM that represents “No More Copy”, see, Col. 12, lines 19-21, which is contrary to the recording unit as claimed in Claim 1, which specifically states that its recording unit is “lacking capability to remark said material with a copy-no-more indication”. As noted in the specification, a key feature of applicants’ system is that it does not include a secondary detector or a remarker in the recording unit and in particular, that its copy-once functionality is performed outside of the recording unit so as to reduce the cost of the recording unit, see, page 8, lines 17-25 of the specification. Therefore, the compliant recording apparatus 200 cannot anticipate the recording unit of Claim 1.

Claim 1 is therefore believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. for the foregoing reasons.

Claims 2, 4-7 and 9-21 are also believed to patentable under 35 U.S.C. 102(e) over Ogino et al., since they depend from Claim 1, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 1. Claim 3 has been cancelled.

Further, Claim 10 recites a recording unit that is “capable of communicating information of finding said copy-once indication back to said preprocessing unit if a secure channel is established between said recording unit and said preprocessing unit”, and such capability of communication, or the desirability of such, from the recording unit (i.e., compliant recording apparatus 200 or 400 of Ogina et al.) back to the preprocessing unit (i.e., the set top box 1 or compliant reproducing apparatus 100 of Ogina et al.) is neither taught nor suggested in Ogina et al.

Also, Claim 12 recites that the “secure channel is established between said recording unit and said preprocessing unit after said copy-once indication is found in said material by said recording unit”, and such a secure channel is neither taught nor suggested in Ogina et al.

Additionally, Claim 13 recites a preprocessing unit that is “capable of responding to said information of finding said copy-once indication received from said recording unit as

though said preprocessing unit had itself found said copy-once indication", and such a preprocessing unit is neither taught nor suggested in Ogina et al.

As stated in the specification, "another key feature of this system is the addition of certain added logic in the preprocessing unit and recording unit that compensates for a failure of the preprocessing unit to properly detect a copy-once indication in received material."

See, page 9, line 25 to page 10, line 4 of the specification. Thus, the added functionality of the recording unit and preprocessing unit as recited in dependent Claims 10 and 13 provide a key additional feature of applicants' system that is neither taught nor suggested by Ogina et al.

Also, with respect to Claims 15, 16, 17 and 19, the terms "expansion board", "video capture board", "network board", and "network appliance" are not found in Ogina et al., and the references cited in the Office Action with respect to these claims fail to teach or suggest such items.

Claim 22 recites a method implemented in a recording unit including the function "if said copy-once indication is detected, then transmitting information of said detection of said copy-once indication back to a sender of said material provided a secure channel is established with said sender, otherwise not allowing copying of said material," and such transmission is neither taught nor suggested in Ogina et al., as explained above in reference to Claims 11 and 13.

Although the Office Action asserts that this function is disclosed in Col. 12, lines 19-29 of Ogina et al., a careful reading of that paragraph fails to teach or suggest the function. In particular, the cited paragraph describes step S105 of FIG. 9 in which the CGMS rewriting unit 206 and the WM rewriting unit 207 of the compliant recording apparatus 200 respectively rewrite the CGMS information from (10) to (11) and the electronic watermark information WM to "No More Copy". There is no discussion in Ogina et al. of transmitting a copy-once (i.e., "One Copy") indication back to the sender of the material as claimed in Claim 22.

Accordingly, Claim 22 is believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. for the foregoing reasons.

Claims 23-34, 36-39 and 41 are also believed to patentable under 35 U.S.C. 102(e) over Ogino et al., since they depend from Claim 22, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 22, as well as any applicable reasons stated in reference to Claims 10, 13, 15, 16, 17 and 19.

Claim 42 has been amended to recite a recording unit including compliance logic configured such that "if either said copy-never or said copy-once indication is detected, then providing information of such detection back to a sender of said material," and such a recording unit is neither taught nor suggested by Ogina et al. for at least the reasons stated in reference to Claims 10 and 22 above.

Accordingly, Claim 42 is believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. for the foregoing reasons.

Claims 43-54 and 56-63 are also believed to patentable under 35 U.S.C. 102(e) over Ogino et al., since they depend from Claim 42, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 42, as well as any applicable reasons stated in reference to Claims 10, 13, 15, 16, 17 and 19.

Claim 64 has been amended to incorporate the claim limitations of Claim 65 and accordingly, Claim 65 has been cancelled.

As amended, the recording unit of the claimed system includes compliance logic configured such that "if said copy-once indication is detected, then establishing a secure channel with said preprocessing unit and passing information of said detection of said copy-once indication back to said preprocessing unit over said secure channel", and Ogino et al. fails to teach or suggest such compliance logic for at least the reasons stated in reference to Claim 10, 22 and 42.

Accordingly, Claim 64 is believed to be patentable under 35 U.S.C. 102(e) over Ogino et al. for the foregoing reasons.

Claims 66-80 are also believed to patentable under 35 U.S.C. 102(e) over Ogino et al., since they depend from Claim 64, and as such, are believed to be patentable for at least

the same reasons as stated in reference to Claim 64, as well as any applicable reasons stated in reference to Claims 10, 13, 15, 16, 17 and 19.

3. Rejection of Claims 8, 35, 40 and 55 under 35 U.S.C. 103(a).

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

Claim 8 is believed to be patentable under 35 U.S.C. 103(a) over Ogino et al. in view of Stallings since it depends from Claim 1, and as such is believed to be patentable for at least the same reasons as stated in reference to Claim 1.

Claims 35 and 40 are believed to be patentable under 35 U.S.C. 103(a) over Ogino et al. in view of Stallings since they depend from Claim 22, and as such are believed to be patentable for at least the same reasons as stated in reference to Claim 22.

Claim 55 is believed to be patentable under 35 U.S.C. 103(a) over Ogino et al. in view of Stallings since it depends from Claim 42, and as such is believed to be patentable for at least the same reasons as stated in reference to Claim 42.

Claims 1, 2, 4-64, and 66-80 are pending in the application. Claims 3 and 65 have been cancelled. Reconsideration of the rejected pending claims is respectfully requested, and an early notice of their allowance earnestly solicited.

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Respectfully submitted,



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